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| 10/738,374 | 12/17/2003 | Liang-Jie Zhang | SOM920030009US1 | 7270 |
| 59559 7590 01/27/2009 RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560 | | | | |
| EXAMINER ANDERSON, FOLASHADE | | | | |
| ART UNIT 3623 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/738,374

Applicant(s)

ZHANG ET AL.

Examiner

FOLASHADE ANDERSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 20-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This office action is made final in response to Applicant's submission filed on 10/20/2008. Currently, claims 20-22 are pending. Claims 1-19 are previously canceled.

Response to Amendment

2. Applicant's amendment to claim 20 is not sufficient to overcome the 35 USC 101 rejection set forth in the previous office action. Claim 20 recites "computer implemented" in the preamble, however this is considered a nominal tie that does not satisfy the requirement, wherein a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicant has failed to amend the claims to recite the tie to another statutory class with the functional language of the claim instead of the preamble therefore the 35 USC 101 rejection is maintained.

Response to Arguments

3. Applicant's arguments with respect to the 35 USC 101 have been fully considered but they are not persuasive. Applicant asserts that claim 20 meets the transformation of subject matter into a different state or thing requirement under 35 USC

101, because the claim decomposes one or more task associated with an enterprise process into one or more subtasks, and adds annotation to the one or more subtasks.

The Examiner respectfully disagrees. Applicant has not transformed the data in to a new state i.e. water to ice or a new thing, i.e. simple manipulation of abstract ideas without some claimed practical application as is the case in the instant application, see MPEP 2106.

4. Applicant's arguments with respect to the 35 USC 103 which are directed towards newly amendments which have been fully addressed in the update rejection Applicant argues Edinger fails to teach (1) obtaining a request in a message in a predefined format from an enterprise process and (2) an enterprise process that is associated with an enterprise activity which requires a collaboration of a plurality of enterprise entities for completion.

5. Lastly Applicant makes general allegations of patentability without specifically pointing out how the language of the claims patentably distinguishes them from the references. Edinger teaches a technical escalation which allows for the repeating of the process. (0273). These allegations fail to comply with 37 CFR 1.111(b).

Examiner notes the following discussion of Official Notice taken from the MPEP:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also

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Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicants have not "specifically point[ed] out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." Applicants' silence to Examiner's taking of Official Notice constitutes an admission of prior art. For these reasons, the feature of "the step of repeating one could select from any of the [previously] taught actions" (as per claim 20) is taken to be admitted prior art because Applicants' traversal was inadequate.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim20, the claim language recites the steps of obtaining a request, decomposing the one or more task, mapping the one or more subtask, etc., however the claim language does not include the required tie or transformation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being obvious over Edinger et al (2002/0194047 A1) in view of Tinti et al (US Publication 2003/0163346).

The applied reference has a common *assignee* with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome

by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

In regards to claims 20-22 Edinger teaches a computer implemented method of managing escalation of a process associated with an enterprise, the method comprising the steps of:

- **obtaining a request in a message in a predefined format from an enterprise process associated with an enterprise (0089), the enterprise process having one or more tasks associated therewith, (0128-0163 where the request type to be the task of request for example) wherein the enterprise process is associated with an enterprise activity which requires a collaboration of a plurality of enterprise entities for completion;**

- **decomposing the one or more tasks associated with the process into one or more subtasks (0164) the decomposing being in accordance with one or more escalation policies, the one or more escalation policies identifying at least one decision maker of the enterprise activity (0273);**
- **mapping the one or more subtasks to one or more roles (0251-0254 where routing and mapping are known synonyms in the art and where the agent performs the role for example in (0253) the role is software support); allocating one or more available resources for the one or more roles (0276);**
- **launching at least one communication session such that data associated with the process is transferable to the one or more allocated resources (0262);**
- **adding annotation to the one or more subtasks such that at least a portion of the annotation may be transferred to the one or more allocated resources (0210);**
- **obtaining one or more responses from the one or more resources (0272); and**
- **performing the selected action (0284);**
- **wherein one or more individuals are associated with the one or more roles (0251-0254 and 0276), and the one or more resources comprise one or more computing devices (0307 where the resources associated with service delivery type for software problems implies computing device).**

Additionally Edinger teaches 0273, an escalation disclosed being repeating of the previous steps. Edinger does not expressly teach **selecting an action to perform, wherein the action is selected from actions comprising launching a new communication session based on at least a portion of the one or more responses from the one or more allocated resources or a task management policy, reallocating one or more new resources, aggregating the one or more responses from the one or more allocated resources, and providing a response to the enterprise process**

Edinger discloses all of the actions, see citations above, from which selection is to be made, with the exception of a **task management policy** see (0100) and **providing a response to the process**. Edinger teaches the actions of this limitation and additionally he teaches repeating previous steps, however he does not expressly teach the old and well known feature of selecting. However selecting is implied in the action of repeating a previous step. It would have been obvious to one of ordinary skill in the art in the step of repeating one could select from any of the taught actions. Thus as claimed and in light of the recent KSR decision selecting from a group of known elements to yield predictable results renders the claim obvious.

Further Edinger does not teach **a message in a predefined format and wherein the enterprise process is associated with an enterprise activity which requires a collaboration of a plurality of enterprise entities for completion**.

Tinti teaches **a message in a predefined format** (abstract and 0028).

It is noted that the wherein portion of the claimed invention is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Nonetheless Tinit teaches **wherein the enterprise process is associated with an enterprise activity which requires a collaboration of a plurality of enterprise entities for completion (0005).**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Edinger the predefined message format and collaboration features as taught by Tinti since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 21 and 22 which are directed to the apparatus and medium respectively for the implantation of claim 20 are implied in this claim. As recited claims 21 and 22 are substantially similar to claim 20 and are therefore rejected to the same reason give with regards to claim 20.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623